

REMARKS

Applicant thanks Examiner Wyszomierski for the time and courtesy extended to Applicant's representatives during the telephone interview of October 5, 2006, in which the outstanding Office Action was discussed.

In the last Office Action,¹ the Examiner:

- a) allowed claims 1 and 3-11;
- b) rejected claims 12 and 14-17 under 35 U.S.C. § 103(a) as being unpatentable over JP 03-013511; and
- c) indicated that objected-to claim 13 would be allowable if rewritten in independent form.

Claims 1 and 3-19 are currently pending, of which claims 18 and 19 are withdrawn from consideration. Claims 1 and 3-17 are under examination.

Applicant gratefully acknowledges the Examiner's indication of allowable subject matter in claims 1, 3-11, and 13.

Applicant respectfully traverses the Examiner's rejection of claims 12 and 14-17 under 35 U.S.C. § 103(a) as being unpatentable over JP 03-013511. A *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement of characterization in the Office Action.

Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2143 (8th ed. August 2006 revision).

Here, a *prima facie* case of obviousness has not been established for at least the reason that JP 03-013511 fails to teach or suggest each and every element recited in independent claim 12.

JP 03-013511 teaches a method of producing a needle-shaped magnetic metal powder by gas phase thermal decomposition of a diluted transition metal carbonyl compound, and subsequently exposing the metal powder to oxygen to form an oxide film on the surface of the powder. The Examiner concedes that JP 03-013511 “does not disclose using the produced particles as a catalyst in a reaction that inhibits the pyrolyzing step, as required by the instant claims.” Office Action at page 2. The Examiner alleges, however, that “the actual chemical reactions that occur in JP ‘511 appear to be ***identical or substantially so*** to those that occur in the present invention” (emphasis added). Office Action at page 2. Applicant respectfully disagrees.

Claim 12 recites, among other things, “producing an inhibition component, which inhibits the pyrolyzing, from a reaction inhibitor generating gas with the produced particles used as a catalyst.” Contrary to the Examiner’s allegations, JP 03-013511 does not disclose chemical reactions that are substantially identical to the method recited in claim 12. Specifically, JP 03-013511 fails to teach or suggest any of an inhibition component, a reaction inhibitor generating gas, or using a produced particle as a catalyst, which are all required by claim 12. In fact, the chemical reaction disclosed in JP 03-013511 is absolutely silent as to any mechanism for inhibiting the powder

producing reaction. Rather, the thermal decomposition reaction of JP 03-013511 is simply controlled by the reactant concentration, the reaction temperature, and the duration of the reaction. See JP 03-013511, pages 7-8.


Therefore, contrary to the Examiner's allegations, JP 03-013511 does not teach or suggest each and every element of the claimed method, and accordingly no *prima facie* case of obviousness of claim 12 has been established. Claim 12 is thus allowable over JP 03-013511, and claims 14-17 are also allowable at least due to their dependence from claim 12.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 19, 2006

By: 
Selah C. Park
Reg. No. 57,127